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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,689	10/13/2000	William J. Bussick	0112300/474	7705

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EXAMINER

JONES, SCOTT E

ART UNIT PAPER NUMBER

3713

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/687,689	Applicant(s) BUSSICK ET AL.	
	Examiner Scott E. Jones	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,9,10,12,13,15,17,20,22,25-28,31,32,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,9,10,12,13,15,17,20,22,25-28,31,32,34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/13/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01232004,02092004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on December 29, 2003 in which applicant amends claims 1, 9, 10, 13, 17, 20, 22, 31, 32, 34, and 35, cancels claims 2, 19, 21, 23, 29, and 30, and responds to the claim rejections. Claims 1, 3-4, 7, 9-10, 12-13, 15, 17, 20, 22, 25-28, 31-32, and 34-35 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4, 7, 9-10, 12-13, 15, 17, 20, 22, 31, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Halloran (U.S. 6,439,993).

O'Halloran discloses a method and apparatus for operating a gaming machine having a plurality of simulated spinning reels capable of displaying a wild card symbol at any of the reels. Upon the appearance of a first wild card symbol, additional wild card symbols may appear, providing the player with additional opportunities to win a prize, or to win an additional prize.

O'Halloran discloses:

Regarding Claim 1:

- maintaining a list of award-yielding symbol combinations of said plurality of symbols in a controller (column 2, lines 36-40 and 48-51);

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- randomly generating on a plurality of paylines associated with said reels a first set of the symbols from the plurality of symbols, said first set including a plurality of symbols generated on each of a plurality of the reels (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing a player an award for each award-yielding symbol combination appearing in said first set on any of the paylines before any said symbol can be replaced (column 3, lines 18-30 and claim 3);
- selecting a plurality but not all of the symbols in the first set for individual replacement, said symbols being all of the plurality of symbols generated on one of the reels and individually replacing each said selected symbol in the first set with one of the plurality of symbols to generate a second set of the symbols, the second set of symbols displayed in place of the first set of symbols (column 3, lines 18-30 and claim 3); and
- providing the player an award for each award-yielding symbol combination appearing in said second set on any of the playlines even if any said award yielding symbol combination in the second set appeared in the first set and even if an award is provided for said symbol combination in the third bulleted paragraph recited above (column 3, lines 18-30 and claim 3).

Regarding Claim 4:

- the step of replacing the symbols includes individually replacing the selected symbols without spinning the reels (column 2, line 60-column 3, line 9, column 3, lines 18-30, and claim 3).

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Regarding Claim 7:

- the first set of symbols and second set of symbols is part of a bonus game (column 2, line 60-column 3, line 9). The appearance of a first wild symbol in a combination is a trigger for and is inclusive to the bonus game which comprises replacing other non-wild card symbols with other wild card symbols for an additional prize amount.

Regarding Claims 9 and 15:

- the step of replacing each selected symbol in the first set includes substituting a wild symbol for each selected symbol (non-wild card symbol) in the first set, and wherein each wild symbol functions as one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claim 10:

- the step of replacing each selected symbol in the first set includes substituting a wild symbol for each selected symbol (non-wild card symbol) in the first set, and wherein each wild symbol sequentially functions as at least one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claim 12:

- the step of replacing each selected symbol includes individually replacing one of the other symbols on a plurality of reels, wherein said symbol functions as one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claim 13:

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- the step of replacing each selected symbol in the first set includes substituting a wild symbol for at least one symbol on another one of said reels, wherein each said wild symbol functions as one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claims 17, 20, and 22:

- maintaining in a controller of said gaming device a list of award-yielding symbol combinations of said plurality of symbols (column 2, lines 36-40 and 48-51);
- generating a first set of said symbols on the reels, wherein one of said symbols in said first set is a first wild symbol, said first set including a plurality of generated symbols on each of a plurality of the reels (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing a player an award for each award-yielding symbol combination appearing in said first set including any award symbol combinations that include the first wild symbol, the first wild symbol functioning as one of the other symbols to maximize the award yielding combinations (column 3, lines 18-30 and claim 3);
- selecting a plurality but not all of the symbols in the first set except for the first wild symbol in the set for individual replacement, said symbols being all of the plurality of symbols generated on one of the reels and individually replacing each said selected symbol with a second wild symbol to create a second set of symbols that is displayed in place of the first set of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, column 3, lines 18-30 and claim 3); and

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- providing the player an award for each award-yielding symbol combination appearing in said second set including any award yielding symbol combinations created with the first wild symbol and any award yielding symbol combinations created with the first and second wild symbols, wherein each of the first and the second wild symbols function as one of the symbols to maximize the award yielding symbol combinations, wherein the award for each award yielding symbol combination in the second set is in addition to the award for each award yielding symbol combination in the first set (column 1, lines 31-44 and 48-54, column 2, lines 54-59, column 3, lines 18-30 and claim 3).

Regarding Claims 31 and 34:

- randomly generating on a plurality of paylines associated with the reels a first set of said symbols, said first set including a plurality of symbols on each of a plurality of reels (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing a player an award for each award-yielding symbol combination appearing in said first set on any of the paylines (column 3, lines 18-30 and claim 3);
- selecting a plurality but not all of the symbols in the first set for individual replacement, said symbols being at least two predetermined symbols on the reels and individually replacing each said selected symbol with one of the symbols to create a second set of symbols that is displayed in place of the first set of symbols (column 3, lines 18-30 and claim 3); and

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- providing the player an award for each award-yielding symbol combination appearing in said second set on any of the playlines including all award yielding symbol combinations in the second set even if an award was provided for such award yielding combinations in the first set and even if an award is provided for said symbol combination in the second bulleted paragraph recited above (column 3, lines 18-30 and claim 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-28, 32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (U.S. 6,439,993).

O'Halloran discloses that as discussed above regarding claims 1, 4, 7, 9-10, 12-13, 15, 17, 20, 22, 31, and 34.

Regarding claims 32 and 35, O'Halloran seems to lack explicitly disclosing:

- providing a player an award for each award yielding symbol combination appearing in said second set, including each award yielding combination including said first wild symbol only and including both the first and the second wild symbols.

Although O'Halloran does not disclose providing the player an award for the first symbol combination again during the second evaluation, it would have been obvious to do so given the

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teaching of O'Halloran. One would be motivated to provide the player the award for the first symbol combination again during the second evaluation to increase the interest of players of the gaming machines by providing new and commercially useful game functions, to increase sales of the machines by vendors, and to increase revenues for casino operators.

O'Halloran seems to lack explicitly disclosing, regarding claims 25-28, the gaming device method is implemented via a data network. However, to one having ordinary skill in the art at the time of Applicant's invention, operating a gaming device over a network, whether the network is a LAN, WAN, or the Internet, was notoriously well known. One would be motivated to operate the gaming machine over a network such that a casino management system could monitor all monetary exchanges between the gaming machines and players.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (U.S. 6,439,993) in view of Jaffe (U.S. 6,551,187).

O'Halloran discloses that as discussed above regarding claims 1, 4, 7, 9-10, 12-13, 15, 17, 20, 22, 31, and 34. O'Halloran seems to lack explicitly disclosing the step of individually replacing the symbols includes an animation of the symbols are replaced.

Jaffe, like O'Halloran, teaches of a gaming machine wherein wild symbols replace other symbols on winning or scattered paylines to provide a player an additional award. Therefore, Jaffe and O'Halloran are analogous art. Jaffe teaches of wild symbols that streak across the reels and hide behind the symbols they are replacing (figs. 5-16). It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Jaffe's animation symbol replacement feature in O'Halloran. One would be motivated to do so because there is a

continuing need to develop new features to further enhance the level of player excitement offered by bonus games as Jaffe's streaking feature accomplishes.

Response to Arguments

7. Applicant's arguments and amendments filed December 29, 2003 have been fully considered.
8. Applicant's arguments, see page 11, filed December 29, 2003, with respect to the objection to claims 26 and 28 have been fully considered and is persuasive. The objection to claims 26 and 28 has been withdrawn.
9. Applicant alleges the claims have been amended to patentably distinguish over O'Halloran. Applicant alleges claims 1, 17, 31, and 34 have been amended to clarify that the total award provided to the player includes an award for the first evaluation and an award from the second evaluation, wherein the award for the second evaluation includes the award from the first evaluation and the award obtained after the symbol(s) change. However, the examiner believes the claims describes that a player is provided an award for a first evaluation and is provided an award for a second evaluation in addition to the first evaluation. The examiner believes this feature is claimed better in claims 32 and 35, however, the claim language seems somewhat vague. Nevertheless, the examiner believes the claimed feature is obvious in view of O'Halloran.
10. Applicant alleges O'Halloran only discloses changing the wild symbols in the same row to wild symbols or functional symbols. Furthermore, applicant alleges O'Halloran does not disclose, teach, or suggest changing all of the symbols generated on the reel into functional or wild symbols. The examiner respectfully disagrees. Although O'Halloran's description is

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limited to one winning line, more than one winning line can be defined and selected by the player (Column 2, lines 50-54). Therefore, one could envision symbols on each of the win lines being changed to wild or functional symbols, wherein the changed symbols could all be on the same reel but different win lines.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

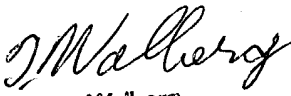
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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